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Appl. No.	:	10/045,151
Applicant	:	Robert C. Lehr
Filed	:	January 15, 2002
Title	:	HARDWARE PAY-PER-USE
TC/A.U.	:	3689
Examiner	:	Michael J. Fisher
Docket No.	:	100201014-1
Customer No.	:	022879

Mail Stop Reply Brief - Patents
Commissioner of Patents
P.O. Box 1450
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REPLY BRIEF UNDER 37 C.F.R. §41.37

I. RESPONSE TO EXAMINER'S ANSWER

On page 2 the December 10, 2009 Final Office Action rejects claims 1 – 4, 8 – 12, 16, 18 -25, 27, 28, 32, 35, 37 – 41, 44, 45, 47, 48, and 50 - 54 under 35 U.S.C. §102(b) over U.S. Patent 5,745,884 to Carnegie et al. (hereafter Carnegie).

The Final Office Action contends that Carnegie discloses "a hardware pay per use system (title) comprising one or more hardware products (col 4, lines 53 – 56), a metering agent that acquires metrics data (306, 316, as best seen in fig. 3), and a usage repository that generates reports on the received data (308, 318)." This statement was the sole basis for rejection of the independent claims, and is an exact replication of the bases for rejection in prior office actions over the 8+ years the instant application has been before the U.S.P.T.O. Now, however, in the June 24, 2010 Examiners' Answer, the Examiner further "explains" the basis for rejecting these claims, namely that "Carnegie most certainly does charge a user based on an operation of the computer, the operation when it connects to their network. The metrics of Carnegie most certainly do 'relate' to the 'operation of the computer', i.e. when it is using their network. That is 'related' to the computer (as it involves the computer) and 'operational' (the operation being 'connecting to the network')." *See* Examiner's Answer, page 8. The Examiner goes on to state "it is incumbent to give [the claims] their broadest possible interpretation." *See* Examiner's Answer, page 8, emphasis added. Finally, the Examiner states "Appellant has never explained why the examiner is wrong on this point, merely argued that the examiner is wrong … this is not proper argument." *See* Examiner's Answer, page 9.

Appellant responds to each of these three points from the Examiner's Answer, enumerated above, as follows.

A. CARNEGIE CHARGES USERS ON A PER CONNECTION BASIS AND APPELLANT HAS PREVIOUSLY EXPLAINED THE FLAW IN THE EXAMINER'S LOGIC

In every Office Action response, in two Appeal Briefs, and one Reply Brief, Appellant has consistently and concisely demonstrated that Carnegie discloses billing a computer user based on a per connection basis only and not based on gathered metrics data related to an operation of the computer. Specifically, Carnegie is directed to a system for collecting revenues from computer users when those computer users connect their computers through a public network, such as the Internet, to their home network or local area network.

See, e.g., Abstract, column 4, lines 30 – 32. Carnegie does not disclose or suggest collecting metrics information related to the operation of the computers, merely the act of connection. *See also*, column 5, lines 45 – 52: Each time a remote user becomes connected to a home system ... the information may be stored for billing purposes on a per user, per connection basis." Clearly, Carnegie's system relates only to connectivity, not operation. Most recently in Appellant's February 12, 2010 Appeal Brief, Appellant went to great lengths to specifically explain what Carnegie discloses and what Carnegie does not disclose. This detailed analysis shows "why the Examiner is wrong." *See* Appeal Brief, pages 11 – 14.

B. THE EXAMINER MISSTATES FEDERAL CIRCUIT LAW AND U.S.P.T.O. GUIDANCE FOR EXAMINATION OF PATENT APPLICATIONS

Federal Circuit case law, and U.S.P.T.O. guidance (e.g., the MPEP) explicitly state that a patent Examiner is to give claims their broadest reasonable interpretation, not their broadest possible interpretation. *See, e.g., In re Finsterwalder*, 436 F.2d 1028, 168 USPQ 530 (1971) (Words in claims are to be given their broadest reasonable interpretation consistent with the specification where the patent has not yet issued and the applicant has an opportunity to change them.); *In re Rovka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974)(The interpretation must be reasonable, since words or terms have to be given the meaning called for by the specification of which they form a part.; MPEP 2111.01 Plain Meaning (Although claims of issued patents are interpreted in light of the specification, prosecution history, prior art and other claims, this is not the mode of claim interpretation to be applied during examination. During examination, the claims must be interpreted as broadly as their terms reasonably allow. *In re American Academy of Science Tech Center*, 367 F.3d 1359, 1369, 70 USPQ2d 1827, 1834 (Fed. Cir. 2004) (The USPTO uses a different standard for construing claims than that used by district courts; during examination the USPTO must give claims their broadest reasonable interpretation in light of the specification). This means that the words of the claim must be given their plain meaning unless the plain meaning is inconsistent with the specification. *In re Zletz*, 893 F.2d 319, 321, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989) ... *Chef America, Inc. v. Lamb-Weston, Inc.*, 358 F.3d 1371, 1372, 69 USPQ2d 1857 (Fed. Cir. 2004) (Ordinary, simple English words whose meaning is clear and unquestionable, absent any indication that their use in a particular context changes their meaning, are construed to mean exactly what they say. Thus, "heating the resulting batter-coated dough to a temperature in the range of about 400°F to 850°F" required heating the dough, rather than the air inside an oven, to the specified temperature.)). Thus, the

Examiner's adoption of a different and more stringent examination and claim term interpretation standard (broadest possible) is in direct contradiction of established Federal Circuit and published U.S.P.T.O. guidance. In essence, the Examiner has adopted no standard at all, and in the prosecution of the instant application, it appears clear that the Appellant may not have received an examination that is in accordance with the proper (broadest reasonable) standard. Furthermore, this is not simply a matter of semantics. There is no way the Examiner's improper "broadest possible" standard can produce the same results as the proper "broadest reasonable" standard. In other words, "possible" and "reasonable" are not remotely similar in meaning, and to the extent the claims of the instant application were examined according to an incorrect standard, Appellant contends the rejections are improper and should be withdrawn.

C. CHARGING USERS ON A PER CONNECTION BASIS DOES NOT ANTICIPATE CHARGING USERS BASED ON ACQUIRED METRICS DATA RELATED TO AN OPERATION OF ONE OR MORE HARDWARE PRODUCTS

Considering claim 1 as illustrating the Appellant's invention, the Examiner's position is totally without support. Claim 1 recites:

> A hardware pay-per-use system, comprising:
>
> one or more hardware products;
>
> a metering mechanism coupled to at least one or the one or more hardware products, wherein the metering mechanism includes a hardware device separate from the one or more hardware products, wherein the metering mechanism acquires metrics data from the one or more hardware products, the metrics data related to an operation at the one or more hardware products, and wherein the metering mechanism determines data to report on the operation of the one or more hardware products; and
>
> a usage repository coupled to the metering mechanism, the usage repository receiving the determined data and generating usage reports related to the operation of the one or more hardware products.

Claim terms are to be given their ordinary meaning unless the applicant has provided a specific definition of the terms. *Phillips v. AWH Corp.*, 415 F.3d 1303, 1313, 75 USPQ2d 1321, 1326 (Fed. Cir. 2005) (*en banc*) (The ordinary and customary meaning of a claim term is the meaning that the term would have to a person of ordinary skill in the art in question at the time of the invention, *i.e.*, as of the effective filing date of the patent application). A person of ordinary skill in the art would understand that a "metric related to an operation of a

hardware product" (i.e., a computer) is a measurable parameter that relates to the product's operation. *See, e.g.,* Newton's Telecom Dictionary.

Carnegie does not disclose billing for computer usage based on acquired metrics related to an operation of the computer. First, the title of Carnegie's patent is "System and Method for Billing Data Grade Network Use **on a Per Connection Basis**" (emphasis added). That is, Carnegie does not bill a user based on an operation of the computer, but instead, bills the user each time the user's computer connects to a network. In Carnegie's system, there are no metrics data recorded or reported, and thus acquired, because there is no need for this information.

Second, the rejection does not address each element of claim 1. For example, claim 1 recites that the acquired metrics data is "related to an operation at the one or more hardware products." Claim 1 also recites that the generated usage reports "[relate] to the operation of the one or more hardware products." Claim 1 further recites the "metering mechanism includes a hardware device separate from the one or more hardware products." The rejection does not address these elements of claim 1.

Third, nowhere in Carnegie's disclosure is anything more than billing based on connection ever disclosed or suggested. Appellant's Appeal Brief enumerated all the various sections of Carnegie that, taken together, make clear that Carnegie does not disclose all the elements of claim 1.

II. CONCLUSION

Appellant has made clear that Carnegie does not disclose billing for computer usage based on acquired metrics data related to an operation of a computer. The examiner has used an incorrect, and non-legal standard for determining claim scope and application examination.

No fees are believed to be due. However, should there be any additional fees required, please charge any fees required to **Deposit Account 08-2025** pursuant to 37 C.F.R. §1.25.

Respectfully submitted,

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